

REMARKS

In the Office Action dated May 13, 2005, claims 12-16, 18 and 20-31 were presented for examination. Claims 12-15 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 7-13 of U.S. Patent No. 6,601,965. Claims 12-16, 18 and 20-24 were rejected under 35 U.S.C. §112, second paragraph, for being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 12-15 and 23 were rejected under 35 U.S.C. §102(b) as being anticipated by *Ohlund*, U.S. Patent No. 6,626,009. Claims 16-18 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Hamilton*, U.S. Patent No. 3,968,357, in view of *Ohlund*, U.S. Patent No. 6,626,009. Claims 16, 18, 20, 22, 26 and 27 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Ohlund*, U.S. Patent No. 6,626,009, in view of *Hamilton*, U.S. Patent No. 3,968,357. Claim 21 was rejected under 35 U.S.C. §103(a) as being unpatentable over *Ohlund*, U.S. Patent No. 6,626,009, in view of *Hamilton*, U.S. Patent No. 3,968,357, and further in view of *Murphy*, U.S. Patent No. 4,262,324.

Applicants wish to thank the Examiner for the telephone discussions of July 6, 2005 and July 21, 2005.

The following remarks are provided in support of the pending claims and responsive to the Office Action of May 13, 2005 for the pending application.

I. Rejection of Claims 12-15 under obviousness-type double patenting

In the Office Action dated May 13, 2005, the Examiner assigned to the application rejected claims 12-15 under the judicially created doctrine of obviousness-type double patenting. Applicant has enclosed herein a Terminal Disclaimer to overcome the double patenting rejection. Accordingly, Applicant respectfully requests that the Examiner remove the double patenting rejection.

II. Rejection of Claims 12-16, 18 and 20-24 under 35 U.S.C. §112

In the Office Action dated May 13, 2005, the Examiner assigned to the application rejected claims 12-16, 18 and 20-24 under 35 U.S.C. §112, second paragraph, as being indefinite. Applicants have amended independent claims 12 and 16 to specify the structure of the medallion, its aperture and the surface mount diode. Claims 13-15, 18, and 20-24 are dependent upon these amendments.

In the Third Office Action, the Examiner rejected the above claims for failing to point out and claims the subject matter regarded as the invention. Based on the telephone conversations of July 6 and 21, 2005, Applicants have amended claim 12 to recite a body for the medallion, and to replace the term "aperture" with the term "channel". These amendments further characterize the structure of the Applicant's medallion and the location of the light emitting diode within the medallion in accordance with the Examiner's queries. Accordingly, the Applicant respectfully request the Examiner to remove this rejection under 35 U.S.C. §112 and requests allowance of claims 12-16, 18, and 20-24.

III. Rejection of Claims 12-15 and 23 under 35 U.S.C. §102

In the Office Action dated May 13, 2005, the Examiner assigned to the application rejected claims 12-15 and 23 under 35 U.S.C. §102(b) as being anticipated by *Ohlund*, U.S. Patent No. 6,626,009.

Ohlund '009 discloses a piece of jewelry with an elongated conducting wire and an ornamental crystal. The ornamental crystal has a housing "32" mounted on an exterior surface of the crystal. The housing includes a cavity with a light emitting diode therein. This mounting of the light emitting diode emits light into the medallion from an exterior surface, and is known in the art as a bullet mounted light emitting diode. Accordingly, *Ohlund* '009 discloses a jewelry item adapted to be illuminated from a light emitting diode mounted to a housing secured to an exterior surface of an ornamental crystal.

Under the law of anticipation, “[f]or a prior art reference to anticipate in terms of 35 U.S.C. §102, every element of the claimed invention must be identically shown in a single reference. *Diversitech Corp. v. Century Steps, Inc.*, 7 USPQ2d 1315, 1317 (Fed. Cir. 1988). Applicant has amended claim 12 to more specifically claim the invention and to elaborate on the opening in the medallion. It is respectfully submitted that in view of the amendment submitted herewith, *Ohlund* ‘009 does not identically teach every element as presented in claims 12-15 and 23. Accordingly, the Applicant’s respectfully request the Examiner to remove this rejection under 35 U.S.C. §102 and requests allowance of claims 12-15 and 23.

IV. Rejection of Claims 16 and 18 under 35 U.S.C. §103(a) and

Rejection of Claims 16, 18, 20, 22, 24, 25, 26, and 27 under 35 U.S.C. §103(a)

In the Office Action dated May 13, 2005, the Examiner assigned to the application rejected claims 16, 18, 20, 22, and 24-27 under 35 U.S.C. §103(a) as being unpatentable over *Hamilton* (‘357) in view of *Ohlund* (‘009).

The comments pertaining to *Ohlund* ‘009 above are hereby incorporated.

The *Hamilton* patent (‘357) discloses an earring with a single medallion and a single channel passing through the medallion. *Hamilton* also discloses a light source in the medallion. However, the light source of *Hamilton* has two parallel electrodes extending from the same point of entry to the light source.

Applicants have amended claims 16, 18, and 25 to further define the aperture formed within Applicant’s medallion. More specifically, applicant’s medallion includes a single linear channel with two points of entry. A light emitting diode is housed within the channel of Applicant. The light emitting diode has two electrodes extending from two different surfaces of the diode, *i.e.* a surface mount diode, such that the first electrode communicates with a first point of entry of the channel, and the second electrode communicates with a second point of entry of the channel.

Absent Applicant's invention, there is no suggestion or motivation to employ a medallion with a single channel having a light emitting diode therein with two electrodes of the light emitting diode communicating with two different points of entry of the channel. While *Ohlund* '009 teaches a medallion with a light emitting diode, the light emitting diode remains outside of the external surface of the medallion and shines light into the medallion. Similarly, while *Hamilton* teaches an earring with a medallion and an opening to receive a light source therein, there is no teaching, suggestion, or motivation to have two separate electrodes in communication with different points of entry of the opening. The prior art must teach the desirability of the modification in question. "The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification." *In re Gordon et al.*, 733 F.2d 900, 221 USPQ 1125, 1127 (Fed. Cir. 1984). There is no suggestion or motivation to mount light emitting diode within a channel of a medallion with a first electrode in communication with a first point of entry of the channel, and a second electrode in communication with a second point of entry of the channel. The desirability of the modification can be found at best only through the use of Applicant's invention. Accordingly, Applicant respectfully requests removal of this rejection and to grant an allowance of claims 16, 18, 20, 22, and 24-27.

V. Rejection of claim 21 35 U.S.C. §103(a)

In the Office Action dated May 13, 2005, the Examiner assigned to the application rejected dependant claim 21 under 35 U.S.C. §103(a) as being unpatentable over *Ohlund* ('009) in view of *Hamilton* ('357) and further in view of U.S. Patent No 4,262,324 to *Murphy* (hereinafter *Murphy*).

The comments pertaining to *Ohlund* '009 and *Hamilton* '357 above are hereby incorporated.

The *Murphy* patent ('324) discloses a necklace with a pendant. An incandescent lamp is mounted in the pendant. Col. 2, lines 64 and 65. The light source of *Murphy* is in the medallion.

However, the light source of *Murphy* has two parallel electrodes extending from the same point of entry to the light source.

Absent Applicant's invention, there is no suggestion or motivation to employ a medallion with a single channel having a light emitting diode therein with two electrodes of the light emitting diode communicating with two different points of entry of the channel. While *Ohlund* '009 teaches a medallion with a light emitting diode, the light emitting diode remains outside of the external surface of the medallion and shines light into the medallion. Similarly, while *Hamilton* teaches an earring with a medallion and an opening to receive a light source therein, there is no teaching, suggestion, or motivation to have two separate electrodes in communication with different points of entry of the opening. With respect to *Murphy*, there is no teaching for the elements of Applicant's claimed invention in independent claim 16. Any dependent claim that stems for an allowable independent claim is also considered allowance. In view of the remarks to claim 16 above, Applicants respectfully requests removal of this rejection and to grant an allowance of claim 21.

VI. Conclusion

For the reasons outlined above, withdrawal of the rejection of record and an allowance of this application are respectfully requested.

Respectfully submitted,

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